REMARKS/ ARGUMENTS

The Office Action of November 30, 2004 has been carefully reviewed and this response addresses the Examiner's concerns. Applicants are grateful to Examiner Duncan for granting a telephone interview to Applicants' representatives, Attorney Jacob N, Erlich and Dr. Orlando Lopez, after the second advisory action.

Status of the Claims

Claims 1 and 3-25 are pending in this application.

Claim 2 is cancelled without prejudice.

Claims 20-25 were rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 20-25 were rejected under 35 U.S.C. 101 because the claimed invention as disclosed is inoperative and therefore lacks utility.

Claims 1, 5, 8-13, 15-16 and 19 were rejected under 35 U.S.C. 102(e) as being anticipated by Buzsaki.

Claims 2-4, 14 and 20-23 were rejected under 35 U.S.C. 1 03(a) as being unpatentable over Buzsaki in view of Winokur et al.

Claims 6, 7, 17, and 18 are allowed.

Claims 1, 3, 13, 20-25 are amended.

Claims 24 and 25 are amended to include the limitations of claim 20 and render claims 24 and 25 in independent claim form.

Support for Amendments to the Claims

The amendments utilize language used in the previously presented claims and, therefore, do not contain new matter.

The 35 U.S.C. §101 rejection

Claims 20-25 were rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 20-25 were rejected under 35 U.S.C. 101 because the claimed invention as disclosed is inoperative and therefore lacks utility.

Claims 20-25 are amended in order to place them in Beauregard form. In *Beauregard,* Gary M. Beauregard et al. appealed the Board of Patent Appeals and Interferences decision rejecting computer program product claims as being non statutory. Since their appeal followed the *In re Lowry* decision (*In re Lowry,* 32 F. 3d 1579 (Fed. Cir. 1994).), the Commissioner stated that "computer programs embodied in a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. § 101 and must be examined under 35 U.S.C. §§ 102 and 103." *In re Beauregard,* 32 F. 3d 1583 (Fed. Cir. 1994). *In re Beauregard* is still good law. Therefore, Applicants respectfully state that claims 20 through 25 claim patentable subject matter under 35 U.S.C. § 101.

Based on the Advisory Action mailed on April 27, 2005, amended claims 20-25 overcome the 35 U.S.C. §101 rejection. Claims 24 and 25 are amended to include the limitations of claim 20 and render claims 24 and 25 in independent claim form since the Advisory Action mailed on April 27, 2005 indicated that claims 24 and 25 contain allowable subject matter.

The 35 U.S.C. §102 rejections

Claims 1, 5, 8-13, 15-16 and 19 were rejected under 35 U.S.C. 102(e) as being anticipated by Buzsaki.

Independent claims 1 and 13 are amended to claim a management system managing at least one network element of a communication network. The Examiner states, in examining claim 2, that Buzsaki (the '193 patent) does not explicitly teach "the managed system being a network element of a communication network." Since the amended claim 1 incorporates the limitations of claim 2, Buzsaki does not anticipate the amended claim.

In order to illustrate the patentable differences between the applicants' claimed invention and the '193 patent, the applicants' claimed invention and the '193 patent are summarized below.

The applicants claim, in claim 1, a method for defining a management policy for controlling behavior of a management system, where the management system manages at least one network element of a communication network, the method comprising the steps of executing a program on a processor-based device that presents a user interface for

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defining the management policy, receiving input from a user, the input identifying management action to be performed by the management policy, and receiving input from a user specifying a modifiable process flow for the management policy to utilize in performing the management action. Since the user, by means of the user interface, can identify the management actions and the order or time sequencing of the management actions in a modifiable process flow, the user can define a management policy that modifies the process flow such that jump statements are included, were in a previous process flow there were no such jump statements (see paragraph 69 and 70 of the applicants' specification).

The '193 patent teaches a system for handling an error by identifying an activity that generated the error. The system determines whether the activity has an associated user-defined error handling process. If the activity has an associated user-defined error handling process, then the system executes the associated user-defined error handling process. If the activity does not have an associated user-defined error handling process, then the system executes a default error handling process. In one instance of the system taught by the '193 patent, the error handling process is a workflow process and users can create or modify a workflow process using a workflow process editing mechanism (col. 4, lines 1-6, the '193 patent). The process definitions are stored in a table or database (120 in Fig. 4, the '193 patent). In such a system, in order to create or modify a workflow process the user has to edit or rewrite the elements of the table and reload the table in some cases. The management system must be shut down, or operate using the previous management workflow process, while the table is being edited, rewritten and reloaded. Therefore, using the teachings of the '193 patent, management behavior (that is, management protocol) can not be changed in major ways, such as introducing jumps, without interrupting management of the network elements.

One difference between the applicant's invention and the '193 patent is the ability provided by the applicant's invention for the user to modify the management policy and, therefore, the process flow of the policy, without having to re-program or change the management policy off-line.

Since amended independent claims 1 and 13 include the limitations of previously submitted claim 2 (now canceled) and some of the limitations of claim 14, amended claims 1 and 13 and their dependent claims are considered under the remarks for the 35 U.S.C. §103 rejection.

The 35 U.S.C. §103 rejections

Claims 2-4, 14 and 20-23 were rejected under 35 U.S.C. 1 03(a) as being unpatentable over Buzsaki in view of Winokur et al.

Since, as stated above, amended independent claims 1 and 13 include the limitations of previously submitted claim 2 (now canceled) and some of the limitations of claim 14, amended claims 1 and 13 and their dependent claims are considered below.

Amended claim 1 claims a method for defining a management policy for controlling behavior of a management system, where the management system manages at least one network element of a communication network, said method comprising:

executing a program on a processor-based device that presents a user interface for defining said management policy;

receiving input from a user identifying management action to be performed by said management policy; and

receiving input from a user specifying a modifiable process flow for said management policy to utilize in performing said management action.

Amended claim 13 claims a management system managing at least one network element of a communication network, the management system comprising:

a software program stored to a data storage device, said software program executable to present a user interface for defining a management policy for controlling behavior of said management system;

at least one processor-based device operable to execute said software program; and

at least one input device communicatively coupled to said at least one processor-based device to allow input from a user to said software program to identify management action to

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be performed by said management policy and to specify a modifiable process flow for said management policy to utilize in performing said management action.

Central to each of these claims is the notion of a management policy used for managing at least one network element of a communication network.

The first step in determining whether a claim is anticipated, or is obvious in view of prior art, is to interpret the claim. ("It is elementary in patent law that, in determining whether a patent is valid ...., the first step is to determine the meaning and scope of each claim in suit." *Lemelson v. Gen. Mills, Inc.*, 968 F.2d 1202, 1206, 23 U.S.P.Q.2D (BNA) 1284, 1287 (Fed. Cir. 1992).) When not defined by applicant in the specification, the words of a claim must be read as they would be interpreted by those of ordinary skill in the art. (MPEP 211.01) (*Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) ("explaining the court's analytical process for determining the meaning of disputed claim terms")).

The term "management policy" has a well-defined meaning in terms of managing at least one network element of a communication network. For example, in his 1994 paper, Sloman defined management policy as "the information which influences the interactions between a subject and a target and so the policy specifies a relationship between the subject and target." (Morris Sloman, POLICY DRIVEN MANAGEMENT FOR DISTRIBUTED SYSTEMS, Journal of Network and Systems Management, Plenum Press. Vol.2 No. 4, 1994, a copy of which was attached to the response mailed on March 30, 2005). The definition of "management policy" has been incorporated into RFC 3198 and RFC 3060 (RFC 3198 available at http://rfc.sunsite.dk/rfc/rfc3198.html and RFC 3060 is available at http://rfc.sunsite.dk/rfc/rfc3060.html, both of which were attached to the response mailed on March 30, 2005). Using the definition that is common to both RFC 3198 and RFC 3060, policies can be defined as a set of rules to administer, manage, and control access to network resources.

Based on the above definition of management policy, replacing management policy in the claims by the above definition of management policy, claim 1 claims a method for defining a

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set of rules to administer, manage, and control access to network resources for controlling behavior of a management system <u>managing at least one network element of a communication network</u>, said method comprising:

executing a program on a processor-based device that presents a user interface for defining the set of rules to administer, manage, and control access to network resources;

receiving input from a user identifying management action to be performed by the set of rules to administer, manage, and control access to network resources; and

receiving input from a user specifying a modifiable process flow for said management policy to utilize in performing said management action

Similarly, claim 13 claims a management system <u>managing at least one network element of a communication network, the</u> <u>management system</u> comprising:

a software program stored to a data storage device, said software program executable to present a user interface for defining a set of rules to administer, manage, and control access to network resources for controlling behavior of said

management system;

at least one processor-based device operable to execute said software program; and

at least one input device communicatively coupled to said at least one processor-based device to allow input from a user to said software program to identify management action to be performed by the set of rules to administer, manage, and control access to network resources and to specify a modifiable process flow for said management policy to utilize in performing said management action.

Comparing Buzsaki to the claimed invention of claims 1 and 13, Buzsaki discloses a user created or modified custom error handling process executed by a process engine (col. 4, lines 1- 6, the '193 patent). Buzsaki does not disclose "a user interface for defining the set of rules to administer, manage, and control access to network resources."

Comparing Winokur et al. (the '637 patent) to the claimed invention of claims 1 and 13, Winokur et al. disclose an expert system for managing error events in a local area network. The expert system disclosed by Winokur et al. includes a knowledge base containing causal relationships between error messages and possible causes and an inference engine utilizing a

causal model to capture and represent the relationship between error messages and actual causes. A user can modify and expand the knowledge base. The causal model generally consists of error messages, causes, and recommended actions. Winokur et al. do not disclose "a user interface for defining the set of rules to administer, manage, and control access to network resources."

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." (MPEP 2143)

Applicants respectfully assert that Buzsaki and Winokur et al either separately or in combination do not teach or suggest all the limitations of claim 1 or claim 13.

Furthermore, applicants respectfully assert that there is no motivation to modify Buzsaki according to Winokur et al or to combine the teachings of Buzsaki and Winokur et al. As stated above, Buzsaki discloses a user created or modified custom error handling process executed by a process engine and Winokur et al. disclose an expert system for managing error events in a local area network. In the combined invention, the user will create or modify a custom error handling process while, at the same time, the expert system would provide a recommended error handling process. Expressing this situation in layman terms, a hand operated hammer (the user provided error handling process) and a nail gun (the expert system provided error handling process) are trying to operate at once; the result of this is either an injured hammer user (the expert system taking precedence over the user provided process) or an impasse where neither process operates (similar to bus contention, both the expert system and the user provided process attempt to operate at the same time). Therefore, combining Buzsaki and Winokur et al. would render Buzsaki unsuitable for the purpose it was intended.

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If the references when combined would render the prior art invention being modified unsatisfactory for its intended purpose, there is no motivation to combine the references. *McGinley v. Franklin Sports, Inc.,* 262 F.3d at 1354; *In re Gordon,* 733 F.2d at 902. Therefore, there is no motivation to integrate the teachings of Buzsaki and Winokur et al..

If the only teaching of Winokur et al. relied on by the examiner is the fact that Winokur et al. teach that the managed system is a network, that is tantamount to the assertion that one of ordinary skill in the relevant art would have been able to arrive at the applicants' invention because he/she had the necessary skills to arrive at such a conclusion. This is not an appropriate standard for obviousness. The fact that elements are known per se does not provide a motivation to combine. See *Orthokinetics Inc. v. Safety Travel Chairs Inc.,* 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). That which is within the capabilities of one skilled in the art is not synonymous with obviousness. *Ex parte Gerlach,* 212 USPQ 471 (Bd.App. 1980).

Thus, assuming *arguendo* that Buzsaki and Winokur et al. either separately or in combination teach or suggest all the limitations of the amended independent claims, there is no motivation to combine.

Therefore, applicants assert that a *prima facie* <u>case of obviousness has not been established</u> and that claims 1, 3-5, 8-16, and 19-23 are patentable over Buzsaki in view of Winokur et al.

In conclusion, in view of the above remarks, Applicants respectfully assert that the claims in this application are now in condition for allowance and respectfully request the Examiner to enter the amendments presented herein and find claims 1, 3-5, 8-16, and 19-25 allowable over the prior art and pass this case to issue.
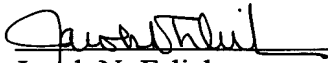
Since the number of independent claims has increased by two, a fee of $400.00 should be charged to Deposit Account No. 50-1078. If additional fees are required, they should be charged to Deposit Account No. 50-1078.

In accordance with Section 714.01 of the MPEP, the following information is presented in the event that a call may be deemed desirable by the Examiner:

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Respectfully submitted,
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Dated: May 27, 2005   By: _Jacob N. Erlich_____

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